B'

6. A process according to claim 1 wherein R is selected from the group consisting of H, a halogen, Me, Bu, t-Bu, OH, MeO, CO_2Me, DMB, PMB, NHMe, NB, NH_2, and mixtures thereof.

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18. A process according to claim 17 wherein R is selected from the group consisting of H, a halogen, Me, Bu, t-Bu, OH, MeO, CO_2Me, DMB, PMB, NHMe, NB, NH_2, and mixtures thereof.

REMARKS

Claims 1 to 20 are pending in this application relating to indolocarbazole syntheses. Claims 6 and 18 were amended to eliminate the appearance of "OH" as a substitutent twice. The undersigned thanks the Examiner for drawing this typographical error to her attention, and apologizes for the inconvenience of having to deal with this oversight.

The above-denominated U.S. patent application serial number 09,482,235 is a divisional of Ser. No. 09/206,082, which issued as U.S. Pat. No. 6,037,468. Both claim benefit of priority applications provisional U.S. Ser. No. 60/002,164, filed August 11, 1995, and PCT/IB96/00987, filed internationally on August 9, 1996.

The claims were rejected under U.S.C. § 102 and 112 for anticipation by a *J.A.C.S.* paper by applicants which set out *in toto* the claimed invention as illustrated by an alkaloid denominated in the paper and in the specification and claims 8, 11, and 19 as compound K252, and for descriptions of substituents as not representing a genus. The rejections are most strenously traversed.[1] This is not a compound case. This is a

[1]The Examiner's rendition of claim 8 is obscure. The undersigned does not have anything like the language recited in the Office Action in her copy of the pending claims, and requests clarification.

process case. The U.S. Patent Office has not met its burden to support the assertion that descriptions in a *J.A.C.S.* paper and a provisional incorporating it is inadequate t skilled alkaloid chemists to follow the instructed synthetic steps, or that the substituent descriptions are inadequate to those skilled in the alkaloid art.

In re Scheiber, 199 USPQ 782 (1978), was relied upon for the proposition that Applicants are not entitled to the benefit of the filing dates of the priority applications. The reliance is misplaced. That case involved an attempt by a prospective patentee to antedate a reference by other investigators by asserting priority benefit of a parent application that did not disclose key signal angle ranges recited in the claims that distinguished the reference, and Appellant openly admitted this. The factual situation is in no way analogous to the one presented in this case, where Applicants have disclosed all the elements of the claimed synthetic process in the parent applications as well as their own papers, which are suddenly perceived as prior art references. Indeed, as pointed out in Dr. Wood's Declaration accompanying this response, the full text of Applicants' original 1995 *J. Amer. Chem. Soc.* paper is set out verbatim in the originally filed provisional application serial number 60/002,164 filed the same year, including all the spectral data. Pending claims 8, 11 and 19 particularly point out an indolocarbazole denoted K252a, which is the subject of the 1995 paper. To assert that this information was presented to the Patent Office in 1998, and not 1995, totally ignores the facts.

In re Lukach, 169 USPQ 795 (1971), was also cited. That case involved the recitation of a claimed key molecular weight ratio of polymers not disclosed in the parent that were used to distinguish a reference by another published between the filing of a foreign priority application and a pending continuation-in-part application. The viscosities and elastomeric properties of component polymers were undisputedly different, as were compositional differences of various alternate polymer combinations. There was no question that the added limitations were important to distinguish claimed polymers from

those disclosed in the prior art. The factual scenari is similar to *Scheiber*, and not to Applicants', who disclosed their claimed process in the parent applications.

In re Kawai, et al., 178 USPQ 158 (1973), was also a compound case. In it, the court thought that a foreign priority document broadly describing benzodiazepine compounds having "excellent pharmacological effects on the central nervous system" (p. 1654, col. 2, 2nd paragraph from the bottom) was insufficient to support a priority claim that would overcome references describing specific compounds and their salts used as anticonvulsants. Again, the key claimed properties were not disclosed in the original application.

Language in *In re Gosteli*, 10 USPQ2d 1615 (1989), the most recent of the cases cited in the Office Action and the only one from the Federal Circuit, is significant and telling. That case found that descriptions of a compound genus in a parent case were insufficient to overcome an intervening reference that described specific species claimed in a later case. There were acknowledged differences between the species. So the Court applied the reasoning of *Gosteli* and *Lukach*. But the Court pointed out at the beginning of the final paragraph of the decision, that the Patent Office has the burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention as defined by the claims.

The Patent Office's burden has not been met here. The rejection of Applicants' priority claims to publications and disclosures of the same research is based upon the assertion that the claimed synetheic process was not disclosed to skilled workers in 1995. The position is patently absurd. The synthetic approach is described in detail, and the key reaction conditions are all set out with example syntheses. The Patent Office's position ignores the facts, the level of skill of alkaloid chemists, the file wrappers of the parent cases, and their prosecution histories (where claims for priority were not questioned). This application contains claims to a process amply described earlier, not groups of specific compounds having different properties described in different publications at

different times by different investigators. All the applications describe the same process devised by the same people at the same time.

As mentioned above, the specification and claims were objected to and rejected under 35 U.S.C. § 112 for the description of the R substituents. As explained in the last office action response dated August 10, 1998, and Dr. Wood's expert testimony in a declaration accompanying that response, the terminology employed by Dr. Wood in his patent application and papers is that employed by alkaloid chemists (and this includes the word "including"). Certainly applicants traverse the rejections. Persons skilled in the art readily understand nomenclature used in the field.

Whereas applicants did not agree with the restriction requirement classes set out in an office action dated November 20, 1997, to expedite allowance, the new case contains, as do the current claims in the above-entitled application, claims directed only to ring expansion (Group III). Applicants submit that their divisional filing puts the case in condition for allowance and respectfully request early and favorable consideration from the Examiner.

If the undersigned can advance the prosecution of the new application in any way whatsoever, the Examiner is invited to communicate using the information set out below.

There are no fees due, but this is also a request to charge Deposit Account No. 25-0110 for any additional extension and/or fee required or credit for any excess fee paid.

Respectfully submitted,

on 20 June 2002 by

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Marked Up Versi n of Claim Amendments Required by 37 C.F.R. § 1.121

6 (Amended). A process according to claim 1 wherein R is selected from the group consisting of H, a halogen, Me, Bu, t-Bu, OH, MeO, CO_2Me, DMB, PMB, NHMe, NB, NH_2, [OH,] and mixtures thereof.

18 (Amended). A process according to claim 17 wherein R is selected from the group consisting of H, a halogen, Me, Bu, t-Bu, OH, MeO, CO_2Me, DMB, PMB, NHMe, NB, NH_2, [OH,] and mixtures thereof.